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Paper No. 12

HRW

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Gabriel Castillo

Serial No. 75/043,780

Thomas E. Anderson of Gifford, Krass, Groh, Sprinkle,
Patmore, Anderson & Citkowski, P.C. for applicant.

Karla Perkins, Trademark Examining Attorney, Law Office 106
(Mary I. Sparrow, Managing Attorney).

Before Simms, Quinn and Wendel, Administrative Trademark
Judges.

Opinion by Wendel, Administrative Trademark Judge:

Gabriel Castillo has filed an application to register
the mark LATIN AMERICAN PEOPLE DEVELOPMENTS for "magazines
in the field of providing information regarding Latin
Americans."¹

Registration has been finally refused on the ground
that the mark is merely descriptive under Section 2(e)(1)

¹ Ser. No. 75/043,780, filed Jan. 16, 1996, based on a bona fide
intent to use.

of the Trademark Act. Applicant and the Examining Attorney have filed briefs, but the request for an oral hearing was withdrawn.

The Examining Attorney maintains that applicant's mark LATIN AMERICAN PEOPLE DEVELOPMENTS is merely descriptive of the subject matter of applicant's magazines, namely "developments of the Latin American people". In the first place, she points out that LATIN AMERICAN PEOPLE is clearly descriptive when used in connection with magazines providing information with respect to "Latin Americans" and that applicant has failed to argue to the contrary. Thus, according to the Examining Attorney, the only question lies in the connotation, and descriptiveness, of the word DEVELOPMENTS when used in connection with applicant's magazines.

The Examining Attorney argues that the word DEVELOPMENTS, as used in connection with magazines dealing with information about Latin Americans, would be viewed as meaning "significant events." In support of her position, she has made of record the definitions found for "development" in *Webster's II New Riverside University Dictionary* (1988), one of which is "a significant event." In addition, the Examining Attorney has submitted a representative sampling of excerpted articles found on the

Nexis database which use the term "developments" in a descriptive manner in connection with the subject matter of various publications. As examples she notes the following in her brief:

Associates are also called upon to contribute to in-house newsletters showcasing recent developments in the firm's various practice areas. *The Legal Intelligence*, Mar. 7, 1997;

"Listeners are going to lose," said Robert Unmacht, editor of The M Street Journal, a newsletter that tracks developments in the industry. *Newsday*, Feb. 17, 1997;

Hot off the press, this book discusses the latest issues and developments in videoconference technology. *PC Week*, Feb. 17, 1997;

...according to Online Banking Report, a newsletter that tracks developments in electronic banking. *Los Angeles Times*, Dec. 17, 1996; and

...shareholders are less than thrilled to be inheriting the company's chemical business, said Gimme Credit, a newsletter that tracks corporate developments. *St. Louis Post Dispatch*, Dec. 15, 1996.

On the basis of this evidence she argues that the mark LATIN AMERICAN PEOPLE DEVELOPMENTS merely describes the subject matter or contents of applicant's magazines, i.e., significant events of or relating to Latin American people.

Applicant, on the other hand, contends that the combination of LATIN AMERICAN PEOPLE with DEVELOPMENTS does not result in a phrase which immediately conveys information with respect to the nature of applicant's

goods. Instead, according to applicant, the purchaser must mentally rearrange the mark before they even begin to understand the scope of the publication. Applicant further argues that not only does the mark standing alone fail to describe or even suggest a publication of any type, but also the term "developments", unlike "news" or "digest" is not commonly used in the magazine field to indicate a magazine publication. Applicant maintains that even the evidence produced by the Examining Attorney does not show use of the term "developments" for a magazine or similar periodical.

A word or phrase is merely descriptive within the meaning of Section 2(e)(1) if it immediately conveys information about a characteristic, purpose, function, or feature of the goods with which it is being used. Whether or not a mark is merely descriptive is not determined in the abstract, but in relation to the goods or services for which registration is sought. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978). Titles of periodicals are not treated any differently from marks for other products and if the title immediately reveals the contents or subject matter of the periodical, the mark is merely descriptive. See *In re Distribution Codes, Inc.*,

199 USPQ 508 (TTAB 1978); In re The Gracious Lady Service, Inc., 175 USPQ 380 (TTAB 1972).

Thus, the question of whether LATIN AMERICAN PEOPLE DEVELOPMENTS is merely descriptive must be resolved taking into consideration the contents of the magazine with which it is intended to be used. The fact that the word "digest" or "news" has not been included in the mark is irrelevant. In order to be merely descriptive the mark need not convey the information in itself that it is the title of a magazine; it is sufficient if it conveys information as to the subject matter of the magazine upon which it appears. See *Andy Warhol Enterprises, Inc. v. Time, Inc.*, 700 F.Supp 760, 9 USPQ2d 1454 (S.D.N.Y. 1988)[INTERVIEW merely descriptive of contents of magazine]; In re Waverly Inc., 27 USPQ2d 1620 (TTAB 1993)[MEDICINE merely descriptive of contents of medical journal]. For additional examples, see 2 J.T. McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 10:8 (4th Ed. 1996).

In the present case, we agree that LATIN AMERICAN PEOPLE DEVELOPMENTS immediately conveys the information to purchasers that this is a magazine about Latin Americans and developments or events which relate to these people. The Examining Attorney has adequately shown that the term "developments" has a recognized meaning as "significant

events" and that publications about the "significant events" in a particular field are often described as tracking the "developments" in that field. Although there may be no evidence of record that others have used the word "developments" in magazine titles, this does not eliminate the descriptiveness of the word as intended to be used by applicant for its particular product. See *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979)[fact that applicant may be first or only one to use a term not controlling on issue of descriptiveness]. Thus, LATIN AMERICAN PEOPLE DEVELOPMENTS when viewed on applicant's magazine would immediately convey the information that the magazine features articles and the like with respect to significant events involving Latin Americans. We do not agree with applicant that it is only after mentally rearranging the mark that any descriptiveness becomes apparent; we consider LATIN AMERICAN PEOPLE DEVELOPMENTS to be just as descriptive as DEVELOPMENTS of LATIN AMERICAN PEOPLE.

Accordingly, we find the mark LATIN AMERICAN PEOPLE DEVELOPMENTS to be merely descriptive of the subject matter of the magazine upon which applicant intends to use it.

Ser No. 75/043,780

Decision: The refusal to register under Section
2(e)(1) is affirmed.

R. L. Simms

T. J. Quinn

H. R. Wendel
Trademark Administrative Judges,
Trademark Trial and Appeal Board

Ser No. 75/043,780